

### REMARKS

Applicants respectfully request further examination and reconsideration in view of the instant response. Claims 1 and 38-76 are pending. Claims 1 and 38-76 stand rejected. Claims 1 and 56 have been amended. No new matter has been added because Claims 1 and 56 were merely amended to improve readability.

### IMPROPER TO MAKE NEXT OFFICE ACTION FINAL

MPEP 2144.04 (D) states, "If...a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. See MPEP 706.07(a)." Claims 1 and 56 were only amended to improve their readability and were not amended to get over the asserted art. Therefore, Applicants respectfully submit that although Applicants amended Claims 1 and 56, should the following arguments be found to be persuasive, Applicants respectfully submit that it would be improper to make the next Office Action final.

### 35 U.S.C. 103(a)

The instant Office Action states that Claims 1 and 38-76 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,529,950 by Lumelsky et al., hereinafter referred to as "Lumelsky" in view of U.S. Patent No. 5,341,477 by Pitkin et al., hereinafter referred to as "Pitkin." Applicants have reviewed the asserted art and respectfully submit that the asserted art does not

describe, teach or suggest the instant Application's claimed embodiments for at least the following rationale.

Applicants respectfully submit that “[i]t is improper to combine references where the references teach away from their combination” (emphasis added; MPEP 2145(X)(D)(2); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Appellant respectfully notes that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). “[A] reference will teach away if it suggests that the line of development flowing from the reference's disclosures is unlikely to be productive of the result sought by the applicant. *In re Gurley*, 31 USPQ2d 1130 (Fed. Cir. 1994).”

“As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries” including “[a]scertaining the differences between the claimed invention and the prior art” (MPEP 2141(II)). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves

would have been obvious, but whether the claimed invention as a whole would have been obvious” (emphasis in original; MPEP 2141.02(I)).

Additionally, MPEP §2141.02 VI provides, “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis added; MPEP 2141.02 VI, *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 [Fed. Cir. 1983], *cert. denied*, 469 U.S. 851 [1984]).

Applicants respectfully note that “[t]he prior art reference (or references when combined) need not teach or suggest all the claim limitations. However, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art” (emphasis added; MPEP 2141[III]).

Applicants respectfully submit that embodiments of Applicants’ Claims 1 and 56 as a whole would not have been obvious, and therefore the instant Office Action does not satisfy the requirements for a rejection of Claims 1 and 56 under 35 U.S.C. §103(a). In particular, Applicants respectfully submit that the instant Office Action fails to explain the differences between Lumelsky, Pitkin and Applicants’ claimed features, in which Lumelsky and Pitkin teach away from features of Applicants’ Claims 1 and 56. Moreover, Applicants respectfully

submit that the instant Office Action fails to explain why these differences would have been obvious to one of ordinary skill in the art.

#### LUMELSKY

This section describes Applicants' understanding of what Lumelsky teaches. Lumelsky teaches a policy-based multivariant application-level negotiation for multimedia services (title, abstract). A client application sends a generic request for a service to a service requestor, which in turns sends the generic request to a negotiator, which in turn sends the generic request to a service mapper that uses a directory to find locations that can satisfy the generic request (Col. 5 line 42 to Col. 6 line 49, Col. 9 line 54 to Col. 11 line 10).

Both the service mapper and the negotiator have policies that they respectively apply to the set of locations that the service mapper finds using the directory to turn the generic request into a specific request (Col. 6 lines 18-36). For example, the service mapper applies policies to the set of locations that it located using the directory. The service mapper communicates the subset of locations that result from applying its policies to the negotiator. The negotiator applies its own policies to the subset of locations resulting in a second subset of locations, which it communicates to the service requestor, which in turn communicates the second subset of locations to the client application. The client application can then send an acceptance of one of the locations in the second subset of locations to the service requestor (Col. 8 lines 26-29).

Therefore, Applicants respectfully submit that the application of policies on a set or a subset of locations to turn a generic request into a specific request is one of Lumelsky's intended purposes. Applicants respectfully submit that applying policies at the service mapper and the negotiator as the found locations are being communicated back to the client application so that the client application can respond by accepting one of the found locations is one of Lumelsky's principles of operation.

#### LUMELSKY TEACHES AWAY FROM CLAIM 1

This section describes Applicants' understanding of why Lumelsky teaches away from independent Claim 1.

Applicants respectfully submit that Lumelsky teaches away from "providing said client...information for locating and contacting said service provider to receive said streaming media from said service provider without utilizing said service location manager," as recited by independent Claim 1. For example, instead of "providing said client ...information for locating and contacting said service provider to receive said streaming media from said service provider without utilizing said service location manager" Applicant understands Lumelsky to teach utilizing Lumelsky's service mapper and negotiator as a part of providing information to Lumelsky's client application. More specifically, Applicants understand Lumelsky to teach applying policies at

the service mapper and the negotiator as the found locations are being communicated back to the client application so that the client application can respond by accepting one of the found locations. Further, Applicants respectfully submit that Lumelsky requires his service mapper and negotiator to apply the policies because the application of policies on a set or a subset of locations to turn a generic request into a specific request is one of Lumelsky's intended purposes. Therefore, Applicants understand Lumelsky to teach away from "providing said client...information for locating and contacting said service provider to receive said streaming media from said service provider without utilizing said service location manager," as recited by independent Claim 1.

Further, since Lumelsky teaches away from independent Claim 1, there is no motivation to combine Lumelsky with any other asserted art, such as Pitkin, to remedy the deficiencies in Lumelsky to render Claim 1 obvious.

#### LUMELSKY TEACHES AWAY FROM CLAIM 56

This section describes Applicants' understanding of why Lumelsky teaches away from independent Claim 56.

Applicants understand Lumelsky to teach away from "said service location manager...for providing said service provider with information to transfer communication from said portal to said service provider for providing said streaming input content to said client device from said service provider," as

recited by independent Claim 56. For example, Applicants understand Lumelsky to teach applying policies at the service mapper and the negotiator as the found locations are being communicated back to the client application so that the client application can respond by accepting one of the found locations. Applicants respectfully submit that applying policies at the service mapper and the negotiator as the found locations are being communicated back to the client application teaches away from “said service location manager...for providing said service provider with information to transfer communication from said portal to said service provider for providing said streaming input content to said client device from said service provider,” as recited by independent Claim 56.

Further, since Lumelsky teaches away from independent Claim 56, there is no motivation to combine Lumelsky with any other asserted art, such as Pitkin, to remedy the deficiencies in Lumelsky to render Claim 56 obvious.

#### PITKIN

This section describes Applicants’ understanding of what Pitkin teaches. Applicants understand Pitkin to state at Col. 2 lines 45-47, “[b]ased upon the policy, the broker thus suggests to the client a server which is best able to satisfy the client’s service request.” At Col. 2 lines 51-55, Pitkin’s states “...the client then requests the service from the recommended server, and the server is responsible for granting the request only if the server currently has the required capacity available for that service.”

## PITKIN TEACHES AWAY FROM CLAIM 1

This section describes Applicants' understanding of why Pitkin teaches away from independent Claim 1.

First, Applicants respectfully submit that "the broker thus suggests to the client a server," (emphasis added; Pitkin Col. 2 lines 45-47), teaches away from "selecting...a service provider to which to assign said media service component," as disclosed by independent Claim 1.

Second, Applicants respectfully submit that "...the client then requests the service from the recommended server, and the server is responsible for granting the request only if the server currently has the required capacity available for that service" (emphasis added; Pitkin, Col. 2 lines 51-55) teaches away from "informing ...said service provider of said assignment to perform said media service component," and "causing said service provider to prepare to perform said streaming media service on streaming media," as recited by independent Claim 1.

Further, since Pitkin teaches away from independent Claim 1, there is no motivation to combine Pitkin with any other asserted art, such as Lumelsky, to remedy the deficiencies in Pitkin to render Claim 1 obvious.



## PITKIN TEACHES AWAY FROM CLAIM 56

This section describes Applicants' understanding of why Pitkin teaches away from independent Claim 56.

First, Applicants respectfully submit that "the broker thus suggests to the client a server," (emphasis added; Pitkin Col. 2 lines 45-47), teaches away from "said service location manager...for selecting a service provider...and informing said service provider that it is assigned to perform said service..." as recited by independent Claim 56.

Second, Applicants respectfully submit that "...the client then requests the service from the recommended server, and the server is responsible for granting the request only if the server currently has the required capacity available for that service" (emphasis added; Pitkin, Col. 2 lines 51-55) teaches away from "said service location manager...for selecting a service provider...and informing said service provider that it is assigned to perform said service..." as recited by independent Claim 56.

Further, since Pitkin teaches away from independent Claim 56, there is no motivation to combine Pitkin with any other asserted art, such as Lumelsky, to remedy the deficiencies in Pitkin to render Claim 56 obvious.

## SUMMARY

Applicants respectfully submit that independent Claims 1 and 56 are patentable for at least the reasons that Lumelsky and Pitkin teach away from independent Claims 1 and 56.

Further, since Pitkin teaches away from independent Claims 1 and 56, Pitkin cannot be combined with any other asserted art, such as Lumelsky, to remedy the deficiencies in Pitkin. Similarly, since Lumelsky teaches away from independent Claims 1 and 56, Lumelsky cannot be combined with any other asserted art, such as Pitkin, to remedy the deficiencies in Lumelsky.

Thus, Applicants respectfully submit that a prima facie case of obviousness has not been met and Claims 1 and 38-76 are patentable over Lumelsky in view of Pitkin and overcome the rejection under 35 U.S.C. 103(a).

### CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1 and 38-76 overcome the rejections of record, and therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

WAGNER BLECHER L.L.P.

Dated: 11/19/2010

/John P. Wagner, Jr./  
John P. Wagner, Jr.  
Registration No. 35,398

Wagner Blecher LLP  
123 Westridge Dr.  
Watsonville, CA 95076  
(408) 377-0500